UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL WILLIAM URBANSKI and CHARLES DAVID DENT

Appeal No. 2006-1251
Application No. 09/714,665
Technology Center 3600

HEARD July 25, 2006

Before OWENS, LEVY and NAPPI, **Administrative Patent Judges.**

NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 1 through 39. For the reasons stated *infra* we will not sustain the examiner's rejection of claims 1 through 39. However pursuant to 37 CFR § 41.50(b) we enter a new grounds of rejection against claims 1, 16, 31 and 32.

THE INVENTION

The invention relates to method of displaying location based information for an information site to users base on the determined location of the user. See pages 2 and 3 of appellants' specification. Claims 1 and 32 are representative of the invention and are reproduced below:

> 1. A computer implemented method of displaying location based information from an information site on a network, the method comprising the steps of:
>
> determining, at the information site, location data of a user of the location based information on the network;
>
> generating, at the information site, location based information based on the determined location data of the user; and
>
> providing the generated location based information to the user over the network,
>
> wherein the step of generating location based information comprises providing information exclusively from respective sponsors in respective categories of information.
>
> 32. A method of displaying information from an information site on a network, the method comprising the steps of:
>
> determining contextual information, other than a location, of a user or a device that uses the information on the network;
>
> generating the information based on the determined contextual information; and
>
> providing the generated information over the network to the user or the device.

THE REFERENCES

The references relied upon by the examiner are:

Thibadeau et al. (Thibadeau)	US 5,432,542	July 11, 1995
Wachob	US 5,155,591	Oct. 13, 1992
Additional references we rely upon		
Angles et al. (Angles)	US 5,933,811	Aug. 03, 1999
Fan	U.S. 6,664,922	Dec. 16, 2003 (Filed Aug. 02, 1999)

THE REJECTION AT ISSUE

Claims 1 through 13, 15 through 28, 30, 31, 36 and 37 stand rejected under 35 U.S.C. § 102 as anticipated by Thibadeau. Claims 14 and 29 stand rejected under 35 U.S.C. § 103 as being unpatentable over Thibadeau. Claims 32 through 35 stand rejected under 35 U.S.C. § 103 as being unpatentable over Thibadeau in view of Wachob.

Throughout the opinion we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of appellants and the examiner, for the reasons stated *infra* we will not sustain the examiner's rejection of claims 1 through 13, 15 through 28, 30, 31, 36 and 37 under 35 U.S.C. § 102, nor will we sustain the examiner's rejection of claims 14, 29 and 32 through 35 under 35 U.S.C. § 103.

Initially we note that the examiner has objected to claims 36 through 39 under 37 CFR § 1.75(c). Appellants have provided no arguments directed to this objection in either the appeal brief or reply brief. However, during oral arguments appellants' representative made comments directed to the objection. 37 C.F.R. § 41.47 (d) states "At the oral hearing, appellant may only rely on evidence that has been previously entered and considered by the primary examiner and present argument that has been relied upon in the

brief or reply brief except as permitted by paragraph (e)(2) of this section." Thus, the arguments presented during oral arguments have not been properly presented and accordingly, have not been considered. Thus, the appeal of these objections is dismissed.

On pages 4 through 6 of the brief, appellants present arguments directed to the examiner's rejections based upon Thibadeau. Appellants argue, on page 5 of the brief, that the claim limitation of an information site refers to a computer server and not a tunable receiver as taught by Thibadeau. Further, appellants assert:

> [E]ach of the independent claims require that generated location based information be provided by the information site to *a user over a network.* Even under the office action's allegation that the tunable receiver of Thibadeau is an information site, nowhere does the office actions allege where the information filtered by the tuner is provided to the user *over a network.* (Emphasis original)

In response, on pages 5 through 7 of the answer, the examiner provides rationale to support equating the claimed information site to Thibadeau's tunable receiver. Further, the examiner states that Thibadeau teaches use of a network in column 12, lines 9-10 and column 5, line 44.

We disagree with the examiner's rationale. Regardless of whether Thibadeau's receivers meet the claimed information site, we do not find that Thibadeau teaches using a network as claimed. Claim 1 recites "providing the generated location based information to the user over the network." Independent claims 16 and 31 contain similar limitations. The examiner has equated the set top unit of Thibadeau with the claimed information site. Thibadeau teaches a set top unit, or receiver, which filters information, transmitted to the set top unit based upon location and provides only the filtered information to the user. See Abstract. The set top unit of Thibadeau can receive the information to be filtered over a network. See column 5 line 44. However, this

network is used to provide all of the information to the set top box, i.e. the information received by the network is not filtered to be location specific information. Thibadeau teaches that the filtered information is provided to the user via a television or other device. See column 14, lines 44 through 60. However, we do not find that Thibadeau teaches that any embodiment where the location specific information is provided to the user over a network. Thus, we do not find that Thibadeau teaches all of the limitations of independent claims 1, 16 and 31. Accordingly, we will not sustain the examiner's rejection of claims 1 through 13, 15 through 28, 30, 31, 36 and 37 under 35 U.S.C. § 102 as anticipated by Thibadeau. Similarly, we do not find that Thibadeau provides a suggestion to use a network as claimed. Thus, we will not sustain the examiner's rejection of claims 14, and 29 under 35 U.S.C. § 103.

Appellants' claim 32 is of a different scope than claim 1 in that it does not contain limitations directed to determining location information; rather it recites, "determining contextual information, other than location." Claim 32, nonetheless recites the limitation of "providing the generated information over the network to the user of the device." As discussed *supra* with respect to claim 1 we do not find that Thibadeau teaches or suggest using a network to provide filtered information. Accordingly, we will not sustain the examiner's rejection of claims 32 through 39 under 35 U.S.C. § 103.

New grounds of Rejection.

Independent claims 1, 16 and 31.

We enter a new grounds of rejection, under 35 U.S.C. § 102(e), against claims 1, 16 and 31 as being anticipated by Fan.

Fan teaches a system where a client provides Global Position System information to a server, where the server obtains location relevant information and provides the location relevant information to the user over a network. See column 1, lines 45 through 54. The location relevant information may include advertising or coupons for business local to the client. See column 11, lines 45 through 50.

Claim 1 includes the limitation of determining, at the location site, location data of the user. Independent claims 16 and 31 recite a similar limitation. Appellants' specification on page 10 lines 24 through 29 describe appellants' step of determining location includes receiving GPS data from the user. Thus, we consider Fan's server, which receives GPS data to perform the claimed step of determining location data of a user. Claim 1 further recites generating at the information site location based information and providing it to the user. Claims 16 and 31 recite similar limitations. We consider Fan's teaching of a server that obtains location relevant information to be provided to the user to meet this limitation. Claim 1 further recites "wherein the step of generating location based information comprises providing information exclusively from respective sponsors in respective categories of information." Claims 16 and 31 recite similar limitations. As asserted by the examiner, on page 5 of the brief, we consider this limitation to constitute descriptive material that does not functionally relate the claimed method. Our reviewing court has stated that "[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability." *In Re Ngai* 367 F.3d 1336, 1339, 70 USPQ2D 1862, 1864 (Fed. Cir. 2004, citing *In Re Gulack* 703 F. 2d 1381, 217 USPQ 401 (Fed. Cir. 1983)). Nonetheless, Fan teaches that the location relevant information may include advertisements which a person of ordinary skill would recognize as being provided by exclusively from sponsors (the companies paying for the advertisement). Thus, we find that Fan describes the invention claimed in independent claims 1, 1 6 and 32. We leave it to the examiner to consider whether the limitations of the claims dependent upon claims 1, 16 and 31 are anticipated by or obvious over Fan.

Independent claim 32.

We enter a new grounds of rejection, under 35 U.S.C. § 102(e), against claim 32 as being anticipated by Angles.

Angels teaches a system for delivering customized advertisements over the Internet. See abstract. In Angles system, when a customer accesses a content provider's web site, the content provider transmits an electronic document to the customer. Embedded in the electronic document is an advertisement. See Column 2, lines 61 through 67. The advertisement is provided to the customer by a separate advertisement computer (see figure 1) or from the content provider's computer (See figure 9). The advertisements are customized based upon the customer's demographic profile. See column 3, lines 7 through 10. The demographic profile can include a variety of information such as age, sex, income, career, interests, hobbies, etc. See column 14, lines 19 through 26. A unique member number, which is stored on the customer's computer, identifies the customer. This number is provided to the content provider's computer and advertisement computer, and is used to select the customer's demographic profile and determine the appropriate advertisements to be presented to the customer. See column 8, lines 8 through 19.

Claim 32 recites "determining contextual information, other than a location, of a user or a device that uses the information on the network;" and "generating the information based on the determined contextual information; and providing the generated information over the network to the user or the device." Appellants' specification identifies, on page 12, that contextual information includes characteristics of the user such as age, gender, profession, subject matter interests etc. Thus, we find that the appellants' claimed contextual information about the user is the same as Angles' demographic information. We consider Angles system, which upon receiving the customer's unique identifier number and determining the customer's demographic information from the number, to meet the claimed step "determining contextual information." Further, we consider Angles teaching of providing advertisements in response to the customer's demographic profile, to meet the claimed step of "generating information based upon the determined contextual information."

We leave it to the examiner to consider whether the limitations of the claims dependent upon claim 32 are anticipated by or obvious over Angles.

CONCLUSION

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

In summary, we will not sustain the examiners rejection of: claims 1 through 13, 15 through 28 , 30, 31, 36 and 37 under 35 U.S.C. § 102 as anticipated by Thibadeau; claims 14 and 29 under 35 U.S.C. § 103 as being unpatentable over Thibadeau; and claims 32 through 35 under 35 U.S.C. § 103 as being unpatentable over Thibadeau in view of Wachob. We dismiss the appeal of the examiner's objection of claims 36 through 39 under 37 CFR 1.75(c). Further, we enter a new grounds of rejection under 37 CFR § 41.50(b) of independent claims 1, 16, 31 and 32.

REVERSED, 37 CFR § 41.50(b)

TERRY J. OWENS Administrative Patent Judge	)
STUART S. LEVY Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
ROBERT E. NAPPI Administrative Patent Judge	)

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